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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/077,658
Filing Date: February 15, 2002
Appellant(s): HUSEMANN ET AL.

William C. Gerstenzang
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 3 0 2006
GROUP 1700

This is in response to the appeal brief filed 6/23/06 appealing from the Office action mailed 7/5/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

DE19807752	Harder	8-1999
DE 4313008	Harder	11-1994
6,242,504	Meyer-Roscher et al	6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2,9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 19807752 to Harder et al, (equivalent to U.S. Patent No. 6,432,529 which is relied on for citations). Harder '752 discloses a non-fogging adhesive tape comprising a non-fogging pressure sensitive adhesive composition. Suitable materials for the pressure sensitive adhesive are acrylic resins, including copolymers of methacrylic acid and ester thereof with 1-25 carbon atoms, maleic, fumaric and/or itaconic acid and/or their esters, substituted (meth)acrylamides, maleic anhydride and other vinyl compounds such as vinyl esters, especially vinyl acetate, vinyl alcohols and/or vinyl ethers. See col. 3, lines 54-63. All of the solvent is removed from the composition and further highly volatiles constituents are removed. See col. 3, lines 25-21. Therefore, the residual solvent content will be below 1% by weight. See col. 3, lines 64-65. The adhesive composition can have a fogging number of 100, which indicates that no detectable evaporation products are present. See col. 5, lines 22-26. The tapes also can be removed easily from substrates with substantially no residue because no fogging occurs. See col. 7, lines 15-20. Harder does not disclose the claimed outgassing level in terms of the residual volatile component fraction as measured by the tesa method. However, since Harder discloses the same composition and further teaches that adhesive is low in fogging, (i.e. low outgassing level), presumably, Harder et al's adhesive would inherently possess the claimed outgassing level.

Claims 3,5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harder et al, DE 19807752, (equivalent to U.S. Patent No. 6,432,870), in view of Harder et al, DE 4313008, (equivalent to U.S. Patent No. 6,613,870), and further in view of Meyer-Roscher et al, U.S. Patent No. 6,242,503. Harder et al, '752 discloses an acrylic pressure sensitive adhesive and an adhesive tape comprising the adhesive as set forth above. Harder et al '752 differs from the claimed invention because Harder et al '752 does not disclose the claimed method of making the adhesive and the tape. Harder '008 teaches that acrylic adhesive compositions may be formed by free-radical polymerization. An entrainer may be employed to further concentrate the polymerizate. The polymer may be extruded. See col. 2, line 16 – col. 3, line 27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the method set forth by Harder '008 to make the adhesive of Harder '752. One of ordinary skill in the art would have been motivated to employ the method of Harder '008 because both references teach acrylic pressure sensitive adhesive compositions and Harder '008 teaches that the disclosed method produces various advantages over prior art processes. See col. 2, lines 31-46. While Harder et al '752 teaches employing UV crosslinkable polymers, it does not specify the use of UV-A radiation. Meyer Roscher teaches at col. 1, lines 16-37 that UV-A radiation is particularly suitable for forming crosslinked pressure sensitive adhesives. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed UV-A radiation as the UV radiation which crosslinks the PSA in

Harder, motivated by the expectation that UV-A radiation is taught by Meyer-Roscher as being particularly suitable for forming crosslinked pressure sensitive adhesives.

(10) Response to Argument

Appellant argues that fogging numbers pertain to condensable components that evaporate from plastics and leave a film on certain substrates such as windshields, but that the instant invention goes far beyond simple fogging numbers and is concerned with the presence of any volatiles. However, since Harder '752 teaches the same compositions, i.e., UV crosslinked acrylic resins which have been further treated to remove all solvents, (col. 3, lines 25-27), and that in addition to removing the solvents, "further highly volatile constituents are removed", (col. 3, lines 30-31), it appears on its face that Harder '752 teaches the same composition as the claimed invention and the burden is on the Appellant to show that the Harder '752 composition is different than the claimed composition.

Appellant argues that a sample having a 0 fogging number can still have a substantial amount of volatile materials. However, it is noted that the materials of Harder '752 have a 100 fogging number which means that no fogging occurred. Further, the statement that the material of Harder '752 "could" still have other volatile materials is not sufficient to meet Appellant's burden to show that the claimed composition is indeed different than the Harder composition. It appears on its face that since Harder '752 relates to the same compositions and is further concerned with eliminating the volatile components as much as possible that the Harder '752 composition is the same as the claimed composition. To state that the composition

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could be different also means that it could be the same. The burden is to show that there is a difference, not that there may or may not be a difference. There is a reasonable basis for presuming that the compositions are in fact the same and Appellant has not presented evidence to rebut this presumption.

Appellant argues that in the instant case the amount of volatiles are measured differently than the fogging test used in Harder '752. However, the fact that a different method of testing is used does not mean that the composition being tested is also different.

Appellant argues that the different treatment of the same or similar composition can lead to different properties. However, it is noted that independent claim 1 merely recites a UV crosslinked pressure sensitive adhesive based at least predominantly on methacrylic acid or derivatives thereof. Harder '752 teaches this composition, including the UV crosslinking. Therefore, there is nothing in claim 1 relating to a different treatment of the pressure sensitive adhesive composition.

Appellant argues that Example 1 of the specification is equivalent to Harder's resin in that it is a conventional acResin. However, there is nothing on the record to state that Harder employs "conventional" acResin. Harder teaches that a variety of resins can be employed, including acrylic resins, including copolymers of methacrylic acid and ester thereof with 1-25 carbon atoms, maleic, fumaric and/or itaconic acid and/or their esters, substituted (meth)acrylamides, maleic anhydride and other vinyl compounds such as vinyl esters, especially vinyl acetate, vinyl alcohols and/or vinyl ethers. See col. 3, lines 54-63. Harder further teaches that these resins should be

treated so that all solvent is removed and that further highly volatile constituents are removed. See col. 3, lines 25-32. Therefore, there is nothing to equate the resin of example 1 with the variety of resins set forth in Harder which have been treated so as to remove both all solvent as well as other highly volatile constituents.

Appellant argues that the examples show that crosslinking by conventional UV-C radiation increases the amount of volatiles. However, it is noted that claims 1-2 and 9-11 do not specify the type of UV crosslinking, and instead merely recite UV crosslinked. Appellant also argues that Harder '752 does not teach the use of an entrainer and does not mention the amount of volatiles present. Again, it is noted that the limitations regarding the entrainer are not found in those claims rejected as anticipated by or obvious over Harder '752. Therefore, arguments which rely on these limitations cannot overcome that grounds of rejection. Further, it is noted that Harder does state that the "volatile constituents are removed" at col. 3, lines 30-31.

Appellant argues that the residue referred at col. 7, lines 1-20 are residues of adhesive. However, Harder '752 clearly equates the lack of adhesive residue and ease of removal of the adhesive with the lacking of fogging and therefore with the lack of volatile constituents.

With regard to claims 3 and 5-13, Appellant argues that example of Harder '008 teaches a volatiles content of 0.8%. However, Harder '008 is not relied on for the volatiles content but to show that the claimed method steps were a known method of making a UV crosslinked acrylic pressure sensitive adhesive. Harder '752 already teaches the low volatiles content pressure sensitive adhesive. Appellant also argues

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that Meyer-Roscher et al is concerned with "controlled-dose exposure" to optimize the PSA properties such as tack, peel resistance and sheer strength and does not suggest that employing UV-A radiation would reduce volatiles. However, the motivation to employ the UV-A radiation taught by Meyer-Roscher would be that Meyer-Roscher teaches that there are many benefits derived from employing UV-A radiation in forming pressure sensitive adhesives. As long as there is a clear motivation to employ the UV-A radiation, the motivation does not have to be the same as Appellant's motivation in order to make the combination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Elizabeth M. Cole

ELIZABETH M. COLE
PRIMARY EXAMINER

Conferees:

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